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RANGREJ, SHEETAL				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/652,849

Applicant(s)

SHORT, DOUGLAS J.

Examiner

SHEETAL R. RANGREJ

Art Unit

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Prosecution History Summary

- Claims 10-14 are cancelled.
- Claims 1 and 15 are amended.
- Claims 1-9 and 15-20 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/15/2008 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The basis of this rejection is based on recent Federal Circuit decisions and Supreme Court precedent in particular, *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S.

584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876) which state that the process must:

- (1) be tied to another statutory class (such as a particular apparatus); or
- (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

For a claimed invention to be statutory subject matter eligible, the claimed invention must fall within a judicial exception. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited claims should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps or positively recite subject matter that is being transformed for example by identifying the material that is being changed to a different state.

4. In the present case, claims 1 and 15 recite an abstract idea only. The claims recite steps and means for a) defining processes, b) forming links between processes, traversing processes by meeting exit requirements. These steps and means do not apply, involve, use, or advance the technological arts since they can be performed in the mind of the user or by use of a pencil and paper. These steps and means only constitute an idea of how to define, linking and traversing processes.

5. In particular, explicitly claiming the medium or structure in the body of the claim that performs the underlying process steps would serve to better recite the technological arts within the present set of claims.

Claim Rejections - 35 USC § 112, Second Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitation “conditioning a benefit under *a policy* for an employee to participation in a voluntary wellness program.” Examiner is unable to interpret whether the policy claimed refers to a state-governed fully-insured health insurance policy or if it is a new policy. For examination purposes, Examiner notes that it is the state-governed fully-insured health insurance policy.

9. Claim 3 recites the limitation “providing an ERISA governed health insurance policy to employees as a non-taxed benefit to an employee, but as *a tax-deductible expense*.” Examiner is unable to interpret which party it is a tax-deductible expense to. For examination purposes, Examiner interprets a tax-deductible expense to the employer.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. *Claims 1-4, and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference V.*

12. As per claim 1, Reference U teaches providing a state-governed fully-insured health insurance policy to a group of employees as a non-taxed compensation to an employee, but as a tax deductible expense to the employer (U: **para. 4, 21, 30-35**); and wherein the state-governed fully-insured health insurance policy is a portion of an insurance contract that provides coverage to the employees in exchange for premium payments paid at least partially by the employer to an insurance provider (U: **para. 4, 21, 30-35**).

Reference U does not explicitly teach conditioning a benefit under a policy for an employee to participation in a voluntary wellness program (U: **para. 16**).

Reference V teaches conditioning a benefit under a policy for an employee to participation in a voluntary wellness program (V: **p. 18, section 5**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of References U and V with the motivation to reduce the amount of days called in sick, claims submitted, etc. (V: **p. 18, section 5**).

13. As per claim 2, the method of claim 1 is as described above. Reference U does not teach said wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category and a regular exercise category.

Reference V teaches said wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category and a regular exercise category (**V: p. 18, section 5**).

The motivation to combine the teachings is the same as claim 1.

14. As per claim 3, the method of claim 2 is as described. Reference U further teaches providing an ERISA governed health insurance policy to employees as a non-taxed benefit to an employee, but as a tax-deductible expense (**U: para. 5**); and structuring the state-governed fully-insured health insurance policy to cover a healthcare expense not covered by ERISA governed health insurance policy (**U: para. 5, 11-14**).

15. As per claim 4, the method of claim 3 is as described. Reference U further teaches a conditional benefit under the state-governed fully-insured health insurance policy includes coverage for at least a portion of a claim falling within a deductible for the ERISA governed health insurance policy (**U: para. 11-14**).

16. As per claim 6, the method of claim 1 is as described. Reference U does not explicitly teach said wellness program includes at least one illness screening and said step of conditioning a benefit includes a step of conditioning coverage for at least a portion of an identified illness to employee participation in an illness screening for the identified illness.

Reference V, however teaches said wellness program includes at least one illness screening and said step of conditioning a benefit includes a step of conditioning coverage for at least a portion of an identified illness to employee participation in an illness screening for the identified illness (**V: p. 18, section 5**).

The motivation to combine the teachings is the same as claim 1.

17. As per claim 7, the method of claim 6 is as described. Reference U does not explicitly teach an identified illness includes at least one of cancer, heart disease, abnormal vision, abnormal orality, and mental illness; and said at least one illness screening includes a cancer screen, a heart disease screen, an abnormal vision screen, an abnormal orality screen and a mental illness screen.

Reference V, however, teaches an identified illness includes at least one of cancer, heart disease, abnormal vision, abnormal orality, and mental illness; and said at least one illness screening includes a cancer screen, a heart disease screen, an abnormal vision screen, an abnormal orality screen and a mental illness screen (**V: p. 18, section 5**).

The motivation to combine the teachings is the same as claim 1.

18. As per claim 8, the method of claim 1 is as described above. Reference U teaches wherein said wellness program includes at least one of wellness education, disease inoculation, injury prevention, and voluntary public service (**U: para. 16-17**).

19. As per claim 9, the method of claim 1 is as described. Reference U teaches a step of providing employees with opportunities to at least one of improve and monitor their wellness condition (**U: para. 16-17**).

20. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference V and further in view of Reference W.

21. As per claim 5, the method of claim 3 is as described. References U and V do not teach increasing a deductible on the ERISA governed health insurance policy relative to a previously provided ERISA governed health insurance policy and making a conditional benefit under the state-governed fully-insured health insurance policy cover at least a portion of the deductible increase.

Reference W, however, teaches increasing a deductible on the ERISA governed health insurance policy relative to a previously provided ERISA governed health insurance policy and making a conditional benefit under the state-governed fully-insured health insurance policy cover at least a portion of the deductible increase (**W: para. 1**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of References U, V, and W with the motivation if the patient had a pre-existing medical condition (**W: para. 8-10**).

22. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference U in view of Reference V and further in view of Gupta (U.S. Publication No. 2003/0009355).

23. As per claim 15, References U and V teach a state-governed fully-insured health insurance policy (**U: para. 4, 21, 30-35**); wherein the state-governed fully-insured health insurance policy is a portion of an insurance contract that provides coverage to the employees in exchange for premium payments paid at least partially by the employer to an insurance provider

(U: **para. 4, 21, 30-35**) with conditioning a benefit under the policy for an employee to participation in a voluntary wellness program (V: **p. 18, section 5**).

The motivation to combine the teachings is the same as claim 1.

References U and V do not teach whether a benefit under health insurance policy is available to an employee making a claim at least in part by determining whether the employee is a participant in a voluntary wellness program.

Gupta teaches determining whether a benefit under health insurance policy is available to an employee making a claim at least in part by determining whether the employee is a participant in a voluntary wellness program (Gupta: **para. 12-14**).

Therefore, it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of References U, V, and Gupta with the motivation of providing access to information and assisting in an informed decision making (Gupta: **para. 8**).

24. As per claim 16, the method of claim 15 is as described above.

References U and V do not teach processing the claim with respect to an ERISA governed health insurance policy that is a companion to the state-governed fully-insured health insurance policy.

Gupta, however, teaches processing the claim with respect to an ERISA governed health insurance policy that is a companion to the state-governed fully-insured health insurance policy (Gupta: **para. 12-14**).

The motivation to combine the teachings is the same as claims 1 and 15.

25. As per claim 17, the method of claim 16 is as described. Reference U teaches providing an ERISA governed health insurance policy to employees as a non-taxed benefit to an employee, but as a tax-deductible expense (**U: para. 5**); and structuring the state-governed fully-insured health insurance policy to cover a healthcare expense not covered by ERISA governed health insurance policy (**U: para. 5, 11-14**).

Reference U and V do not explicitly teach applying the claim to a deductible under a health insurance policy and paying portion of a claim in a supplemental policy (i.e. state-governed fully insured health insurance policy).

Gupta teaches applying the claim to a deductible under a health insurance policy and paying portion of a claim in a supplemental policy (i.e. state-governed fully insured health insurance policy) (**Gupta: para. 38; 43; 54-57**).

The motivation to combine the teachings is the same as claims 1 and 15.

26. As per claim 18, the method of claim 15 is as described. Reference U does not explicitly teach a step of paying at least a portion of the claim if the employee was a member of at least one of said wellness categories before incurring the claim; and wellness program includes a wellness category that includes at least one of a tobacco free category, a normal blood pressure category, a non-overweight category and a regular exercise category.

Reference V teaches a step of paying at least a portion of the claim if the employee was a member of at least one of said wellness categories before incurring the claim; and wellness program includes a wellness category that includes at least one of a tobacco free category, a

normal blood pressure category, a non-overweight category and a regular exercise category (**V: p. 18, section 5**).

The motivation to combine the teachings is the same as claims 1 and 15.

27. As per claim 19, the method of claim 15 is as described. Reference U does not explicitly teach said wellness program includes an illness screening for at least one identified illness; and said determining step includes a step of determining if the claim is based at least in part on said identified illness and whether the employee participated in an illness screening for said identified illness before incurring the claim.

Reference V teaches said wellness program includes an illness screening for at least one identified illness; and said determining step includes a step of determining if the claim is based at least in part on said identified illness and whether the employee participated in an illness screening for said identified illness before incurring the claim (**V: p. 18, section 5**).

The motivation to combine the teachings is the same as claims 1 and 15.

28. Claim 20 recites substantially similar limitations as those already addressed in claims 8 and 18, and, as such, are rejected for similar reasons as given above.

Response to Arguments

29. Applicant's arguments filed for claim 1-9 and 15-20 have been fully considered but they are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/SRR/
Patent Examiner
December 22, 2008

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Group Art Unit 3686